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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,330	02/20/2002	Michael Schwartz	JUR-PT001.1	7961

3624 7590 05/20/2005

VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103

EXAMINER

TRAN, TUAN A

ART UNIT PAPER NUMBER

2682

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/079,330	SCHWARTZ ET AL.	
	Examiner	Art Unit	
	Tuan A. Tran	2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-20 and 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims 1-8 and 21-28 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group of claims, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 01/14/2005.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 9-10, 12-13, 29, 31 and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Hahn et al. (6,230,029).

Regarding claim 29, Hahn discloses an ear wearable transmitting and receiving device 10 (See fig. 3) comprising: a speaker module 14, 24 for playing recorded voice signals (RF signals carrying voice data has been temporarily stored or recorded in order to be reproduced to audio or voice signals), configured to fit at least partially in a wearing individual's ear; a microphone 18 configured to received voice signals of a wearing individual; and a housing containing a transmit/receive device 20 so that the device can communicate with other transmitting and receiving device 54, the housing configured to fit substantially around the wearing individual's ear (See figs. 3, 10 and col. 5 lines 43-57, col. 7 line 22 to col. 8 line 7).

Claim 9 is rejected for the same reasons as set forth in claim 29.

Regarding claim 31, Hahn discloses as cited in claim 29. Hahn further discloses the device fits substantially in and around a single ear of the wearing individual (See fig. 3).

Claim 10 is rejected for the same reasons as set forth in claim 31.

Regarding claims 33-34, Hahn discloses as cited in claim 39. Hahn further discloses the housing comprises the microphone wherein the microphone extends from the housing (See fig. 3).

Claims 12-13 are rejected for the same reasons as set forth in claims 33-34.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11, 14-20, 30, 32 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. (6,230,029).

Regarding claim 32, Hahn discloses as cited in claim 29. Hahn further discloses the housing having an edge at least partially following the back of the single ear (See fig. 3 and col. 5 lines 45-52). However, Hahn does not mention that the speaker module configured to fit substantially in a concha portion of the single ear. Since the speaker module of a headset having a size that can be fitted in a concha portion of the listener's ear is very common in the art; therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the speaker module as disclosed by Hahn with the size that can be fitted in the concha portion of the ear for the advantage of allowing greater customization in the fitting of the headset module to the user's ear.

Claim 11 is rejected for the same reasons as set forth in claim 32.

Regarding claim 35, Hahn discloses a communication device 10 (See fig. 3) comprising: a microphone 18 for receiving audio signals; inherently an amplifier for amplifying a signal provided to a speaker 14, 24; a speaker 24 configured to direct sounds towards an ear canal of a listener's ear and a module 24 configured to fit to the listener's ear; a housing connected to the speaker module 24, the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker, the all other

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components inherently including the amplifier (See figs. 3, 10 and col. 2 lines 45-50, col. 5 lines 43-57, col. 7 line 22 to col. 8 line 7). However, Hahn does not mention that the speaker module configured to fit substantially in a concha portion of the listener's ear. Since the speaker module of a headset having a size that can be fitted in a concha portion of the listener's ear is very common in the art; therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the speaker module as disclosed by Hahn with the size that can be fitted in the concha portion of the ear for the advantage of allowing greater customization in the fitting of the headset module to the user's ear.

Regarding claim 36, Hahn discloses as cited in claim 35. Hahn further discloses the microphone 18 is integrated into an exterior of the housing (See figs. 1-3 and col. 4 lines 43-51).

Regarding claim 37, Hahn discloses as cited in claim 35. Hahn further discloses the housing has a lower surface which makes contact with pinna, and the lower surface is shaped to at least partially follow the pinna and the head connection when worn (See fig. 3 and col. 5 lines 43-52).

Regarding claim 38, Hahn discloses as cited in claim 37, Hahn further discloses the housing is made of a substantially rigid material (See col. 5 lines 44-45).

Regarding claim 30, Hahn discloses as cited in claim 29. However, Hahn does not mention that the other transmitting and receiving devices are ear wearable. Since Hahn does suggest that the ear wearable transmitting and receiving device 10 is capable of communicating with other portable wireless transceiver such as the base

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station 54 (See fig. 10 and col. 7 line 22 to col. 8 line 7); therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the ear wearable device as disclosed by Hahn to communicate with other ear wearable devices for the advantage of expanding the capability of the devices to various types of wireless devices.

Claim 14 is rejected for the same reasons as set forth in claim 30.

Regarding claims 15-19, Hahn discloses as cited in claim 14. However, Hahn does not mention that the transmit/receive device communicates using infrared signals or a Bluetooth interface or a wireless Ethernet interface or a wired interface. Since Hahn discloses the transmit/receive device is capable of communicating using RF signals (See col. 7 lines 49-52) and infrared, Bluetooth, wireless Ethernet and wired are well known communication protocols in the art; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the device as disclosed by Hahn utilizing such protocols for the advantage of expanding the capability of the device to various types of communication protocols.

Regarding claim 20, Hahn discloses as cited in claim 14. Hahn further discloses the transmit/receive device is used to transfer recorded voice signal to a computer (in this case the base station 54) (See fig. 10 and col. 7 lines 56-67).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- DeMars (5,615,410); Freedland (6,148,175); Fischer (2002/0003889);  
Skulley et al. (6,449,374).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(571) 272-7858**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached at **(571) 272-7848**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

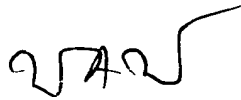
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



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Tuan Tran

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VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
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5/16/05